

REMARKS

The Office Action dated February 5, 2008 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 11-33 and 35-37 have been amended to more particularly point out and distinctly claim the subject matter of the invention. Claims 38-41 have been newly added. No new matter has been added.

Claims 1-7, 10-30 and 33-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bobde et al. (U.S. Patent Publication No. 2003/0217142) in view of Wang (U.S. Patent Publication No. 2002/0131395) and further in view of Requena (U.S. Patent Publication No. 2007/0124472). The Office Action took the position that Bobde disclosed all of the elements of the claims, with the exception of sending a notification from the first element and registrar server to the second element and presence server in response to the register message, and a separate second network element that is separate from the first network element. The Office Action then cited Wang and Requena as allegedly curing these deficiencies in Bobde. This rejection is respectfully traversed for at least the following reasons.

Applicants submit that Requena is disqualified as prior art under 35 U.S.C. §103(c), which provides,

“(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention

was made, owned by the same person or subject to an obligation of assignment to the same person.” (see §2146 of the MPEP).

Requena cannot be used to show obviousness of the claims of the present application, because 35 U.S.C. 103(c) specifically provides that if a reference is only available as prior art under subsection (e) of 35 U.S.C. §102, and if the reference was subject to an obligation of assignment to the same entity as the application under examination, then the reference cannot be used to establish obviousness of the claims of the application under examination. Requena and the present application meet both those qualifications, and consequently the Office Action’s use of the reference is clearly contrary to U.S. law.

Requena would only qualify as prior art under 35 U.S.C. §102(e) because it was filed as a divisional application on January 17, 2007 with a priority date of November 8, 2000 based on the corresponding U.S. patent publication No. 2002/0126701 which published on September 12, 2002. The present application was originally filed as a PCT application WO 03/107621 with a priority date of June 14, 2002. Further, Requena was not published more than one year before the present application. In view of the present application, Requena would only qualify as prior art under 35 U.S.C. §102(e). Therefore, both Requena and the present application meet the first requirement in qualifying as a prohibited reference under 35 U.S.C. 103(c).

In addition, both Requena and the present application were under an obligation of assignment to the same entity as the present application. Requena’s assignee is named on the assignment of record (Reel/Frame – 012697/0248) as “Nokia Corporation,” Similarly,

the present application provides on the assignment of record (Reel/Frame – 016444/0472) “Nokia Corporation,” as its assignee.

The present application was under an obligation of assignment to the same entity as Requena. Accordingly, as has been described in detail above, Requena may not be legally used to show obviousness of the claims of the present application.

As noted above, Requena is disqualified as prior art with respect to the present application. The rejection of independent claims 1, 11, 17, 18, 34 and 35 all rely on the teachings of Requena. Therefore, the rejection of independent claims 1, 11, 17, 18, 34 and 35 is improper and must be withdrawn. By virtue of dependency, all claims dependent thereon are also improperly rejected, the rejection of which must also be withdrawn. Withdrawal of the rejection of claims 1-7, 11-18, 19-30 and 34-37 is respectfully requested.

Claims 8, 9, 31 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bobde in view of Wang, Requena and further in view of Donovan (IMPS – instant messaging and presence using SIP, Fall VON developers conference, September 13, 2000). This rejection is respectfully traversed.

As noted above, Requena is disqualified as prior art with respect to the present application. The rejection of independent claims 1, 11, 17, 18, 34 and 35 all rely on the teachings of Requena. Therefore, by virtue of dependency, the rejection of claims 8, 9, 31 and 32 is also improper and must be withdrawn.

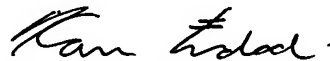
For at least the reasons discussed above, Applicants respectfully submit that the cited references fail to disclose or suggest all of the elements of the claimed invention.

These distinctions are more than sufficient to render the claimed invention unanticipated and unobvious. It is therefore respectfully requested that all of claims 1-41 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: Petition for Extension of Time
Additional Claims Transmittal
Check No. 018876